



IFW

**PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q61659

Kazufumi KAI, et al.

Allowed: August 31, 2005

Appln. No.: 10/088,229

Group Art Unit: 1712

Confirmation No.: 1681

Examiner: Jeffrey Robertson

Filed: March 19, 2002

For: FUMARATE DERIVATIVE, METHOD FOR PRODUCING THE SAME

SUBMISSION OF ART

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

For the possible benefit of anyone subsequently evaluating the scope and/or validity of the above-identified patent, it is requested that the document that is listed below (copy enclosed) be placed in the U.S. Patent and Trademark Office's file wrapper of the above-identified U.S. patent:

1. U.S. Patent 3,336,364

The above-listed document was recently cited in a communication from a Foreign Patent Office dated January 27, 2006. The undersigned has not reviewed the teachings of the above-listed document in detail and thus makes no representations concerning the relevancy or materiality of the above-listed document. This is not an Information Disclosure Statement and no response from the U.S. Patent and Trademark Office is believed to be necessary, nor are any fees believed to be due.

Respectfully submitted,

Keiko K. Takagi
Registration No. 47,121

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: June 7, 2006



✉ EPA/EPO/OEB
D-80298 München
☎ +49 89 2399-0
TX 523 656 epmu d
FAX +49 89 2399-4465

Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Generaldirektion 2

Directorate General 2

Direction Générale 2

Strehl Schübel-Hopf & Partner
Maximilianstrasse 54
80538 München
ALLEMAGNE

Erhalten
31. JAN. 2006
Strehl et al.

Telephone numbers: Branch at The Hague

Primary Examiner (substantive examination) +31 70 340-3483

Formalities Officer / Assistant (Formalities and other matters) +31 70 340-4385



Application No. 01 947 972.4 - 1211	Ref. EPA-53864	Date 27.01.2006
Applicant Showa Denko K.K.		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



Kardinal, S
Primary Examiner
for the Examining Division

Enclosure(s): 3 page/s reasons (Form 2906)
US3336364



The examination is being carried out on the following application documents:

Description, Pages

1-3, 5-87	as published			
4	received on	01.03.2004	with letter of	01.03.2004

Claims, Numbers

30	as published			
1-23	received on	01.03.2004	with letter of	01.03.2004

1. Amendments

1.1 The amendments filed with the letter dated 01.03.2004 comply with Article 123(2) EPC. The objections under points 2.1 to 2.3, 2.6 and 3 of the previous communication are overcome.

1.2 The amendments of claims 1, 2, 5 and 11 and 15-17 addressing points 2.4 and 2.5 of the previous communication do not render these claims more clear than the original wording. In the present case it is suggested to return to the original formulations "organic residue derived from" and "condensing agent", the objections under points 2.4 and 2.5 of the previous communication are not maintained.

2. The present application does not meet the requirements of Article 52(1) EPC, because the subject-matter of claims 1, 4 and 19 is not new in the sense of Article 54(1) and (2) EPC :

2.1 The following document (D7) is cited by the examiner (see the Guidelines, C-VI, 8.7). A copy of this document is annexed to the communication and the numbering will be adhered to in the rest of the procedure :

D7: US-A-3 336 364 (DALE ROBERT DILL, WEBSTER GROVES) 15 Aug. 1967.

2.2 The document D7 discloses (cf. examples 17) 1,4-tetramethylene bis [2,2-di(allyloxymethyl)butyl fumarate falling within the scope of claim 1 when R1 is allyl, X1 is derived from trimethylolpropane, X2 is derived from 1,4-butanediol and the number



of repetitions of the unit represented by formula (2) is two.

The subject-matter of claims 1, 4 and 19 is therefore not new (Article 54(1) and (2) EPC).

3. Furthermore the applicant's attention is drawn to the following points :

3.1 Claim 30 seems to contain all the features of claim 1 and should be formulated as a dependent claim (see the Guidelines, C-III, 3.4).

3.2 It should be considered whether dependent claims 10 and 30 could be arranged more appropriately (see the Guidelines, C-III, 3.5).

3.3 To meet the requirements of Rule 27(1)(b) EPC, the relevant prior art documents, e. g. D1 and D6, should be identified in the description and the relevant background art disclosed therein should be briefly discussed.

4. 4.1 The applicant is requested to file new claims which take account of the above comments. When filing amended claims the applicant should at the same time bring the description into conformity with the amended claims.

Care should be taken during revision, especially of the introductory portion and any statements of problem or advantage, not to add subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC).

4.2 Examples not falling within the scope of the claims should be excised or indicated as reference/comparative examples.

4.3 In order to facilitate the examination of the conformity of the amended application with the requirements of Article 123(2) EPC, the applicant is requested to clearly identify the amendments carried out, irrespective of whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based.

**Bescheld/Protokoll (Anlage)**

Datum
Date
Date 27.01.2006

Communication/Minutes (Annex)

Blatt
Sheet
Feuille 3

Notification/Procès-verbal (Annexe)

Anmelde-Nr.:
Application No.: 01 947 972.4
Demande n°:

If the applicant regards it as appropriate these indications could be submitted in handwritten form on a copy of the relevant parts of the application as filed.



✉ EPA/EPO/OEB
D-80298 München
☎ +49 89 2399-0
TX 523 656 epmu d
FAX +49 89 2399-4465

Europäisches
Patentamt

European
Patent Office

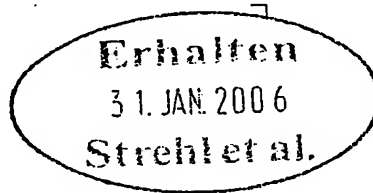
Office européen
des brevets

Generaldirektion 2

Directorate General 2

Direction Générale 2

Strehl Schübel-Hopf & Partner
Maximilianstrasse 54
80538 München
ALLEMAGNE



Telephone numbers: Branch at The Hague

Primary Examiner (substantive examination) +31 70 340-3483

Formalities Officer / Assistant (Formalities and other matters) +31 70 340-4385



Application No. 01 947 972.4 - 1211	Ref. EPA-53864	Date 27.01.2006
Applicant Showa Denko K.K.		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



Kardinal, S
Primary Examiner
for the Examining Division

Enclosure(s): 3 page/s reasons (Form 2906)
US3336364



The examination is being carried out on the **following application documents**:

Description, Pages

1-3, 5-87	as published			
4	received on	01.03.2004	with letter of	01.03.2004

Claims, Numbers

30	as published			
1-23	received on	01.03.2004	with letter of	01.03.2004

1. Amendments

1.1 The amendments filed with the letter dated 01.03.2004 comply with Article 123(2) EPC. The objections under points 2.1 to 2.3, 2.6 and 3 of the previous communication are overcome.

1.2 The amendments of claims 1, 2, 5 and 11 and 15-17 addressing points 2.4 and 2.5 of the previous communication do not render these claims more clear than the original wording. In the present case it is suggested to return to the original formulations "organic residue derived from" and "condensing agent", the objections under points 2.4 and 2.5 of the previous communication are not maintained.

2. The present application does not meet the requirements of Article 52(1) EPC, because the subject-matter of claims 1, 4 and 19 is not new in the sense of Article 54(1) and (2) EPC :

2.1 The following document (D7) is cited by the examiner (see the Guidelines, C-VI, 8.7). A copy of this document is annexed to the communication and the numbering will be adhered to in the rest of the procedure :

D7: US-A-3 336 364 (DALE ROBERT DILL, WEBSTER GROVES) 15 Aug. 1967.

2.2 The document D7 discloses (cf. examples 17) 1,4-tetramethylene bis [2,2-di(allyloxymethyl)butyl fumarate falling within the scope of claim 1 when R1 is allyl, X1 is derived from trimethylolpropane, X2 is derived from 1,4-butanediol and the number



of repetitions of the unit represented by formula (2) is two.

The subject-matter of claims 1, 4 and 19 is therefore not new (Article 54(1) and (2) EPC).

3. Furthermore the applicant's attention is drawn to the following points :

3.1 Claim 30 seems to contain all the features of claim 1 and should be formulated as a dependent claim (see the Guidelines, C-III, 3.4).

3.2 It should be considered whether dependent claims 10 and 30 could be arranged more appropriately (see the Guidelines, C-III, 3.5).

3.3 To meet the requirements of Rule 27(1)(b) EPC, the relevant prior art documents, e. g. D1 and D6, should be identified in the description and the relevant background art disclosed therein should be briefly discussed.

4. 4.1 The applicant is requested to file new claims which take account of the above comments. When filing amended claims the applicant should at the same time bring the description into conformity with the amended claims.

Care should be taken during revision, especially of the introductory portion and any statements of problem or advantage, not to add subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC).

4.2 Examples not falling within the scope of the claims should be excised or indicated as reference/comparative examples.

4.3 In order to facilitate the examination of the conformity of the amended application with the requirements of Article 123(2) EPC, the applicant is requested to clearly identify the amendments carried out, irrespective of whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based.

**Bescheid/Protokoll (Anlage)**

Datum
Date
Date

27.01.2006

Communication/Minutes (Annex)

Blatt
Sheet
Feuille

3

Notification/Procès-verbal (Annexe)

Anmelde-Nr.:
Application No.:
Demande n°:

01 947 972.4

If the applicant regards it as appropriate these indications could be submitted in handwritten form on a copy of the relevant parts of the application as filed.